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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,988	01/05/2001	Paul S. Palumbo	99097CIP	5432

7590

09/30/2003

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EXAMINER

SHOSHO, CALLIE E

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Advisory Action	Application No. 09/754,988	Applicant(s) PALUMBO ET AL.	
	Examiner Callie E. Shosho	Art Unit 1714	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 30-33, 38 and 39.

Claim(s) objected to: 20.

Claim(s) rejected: 1, 5-19, 21-25, 34, 35 and 40-42.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Callie E. Shosho
Primary Examiner
Art Unit: 1714

Attachment to Advisory Action

1. Applicants' amendment filed 9/9/03 has been fully considered but it will not be entered given that the amendment raises new issues that would require further consideration.

Specifically, the amendment to claim 1 raises new issues under 35 USC 112, second paragraph. Claim 1 has been amended to depend on claim 30. Claim 30 recites modified pigment having attached at least one organic group wherein the "organic group comprises the reaction product of at least one electrophile and a nucleophilic polymer which is then further reacted with an acylating agent". Claim 1 recites method of making the modified pigment of claim 30 comprising reacting pigment having attached a first chemical group comprising at least one electrophile with a second chemical group comprising at least one nucleophilic polymer to form the modified pigment having attached at least one organic group.

Thus, the scope of claim 1 is confusing because it is not clear why the organic group of claim 1 is made from reaction of first chemical group, i.e. electrophile, and second chemical group, i.e. nucleophilic polymer, only when claim 30, from which claim 1 depends, discloses organic group made from reaction product of electrophile and nucleophilic polymer which reaction product is then further reacted with acylating agent. That is, the organic group of claim 1 only requires reaction of electrophile and nucleophilic polymer while the organic group of claim 30 requires reaction of electrophile and nucleophilic polymer followed by reaction with acylating agent. Given that claim 1 is drawn to method of making the modified pigment of claim 30, it is not clear why the method does not include acylating agent which is required in claim 30. Given its dependence on claim 30, wouldn't the method of claim 1 necessarily have to include further reaction with acylating agent to form the organic group?

Claim 14 depends on claim 1, and thus, ultimately on claim 30. The amendment to claim 14 raises issues under 35 USC 112, 2nd paragraph. Claim 14 as amended recites that the method further comprises reacting the organic group attached onto the pigment with at least one additional second chemical group. The scope of the claim is confusing because it is not clear if this second chemical group is the same as or in addition to the acylating agent disclosed in claim 30. This is also confusing in light of the disclosures in claim 19 and 20 which each ultimately depend on claim 14 and which each recite that the second chemical group is an acylating agent. Thus, it is not clear if the additional second chemical group is the same acylating agent of claim 30 or is there more than one acylating group reacting with the pigment.

Claim 21 has been amended to depend from claim 30. Claim 21 recites that the organic group is the reaction product of at least one (2-sulfatoethyl)-sulfone and at least one nucleophilic polymer while claim 30 recites that the organic group comprises the reaction product of at least one electrophile and a nucleophilic polymer, which is then further reacted with an acylating agent.

Thus, claim 21 fails to further limit the scope of the claim on which it depends, claim 30, because the organic group attached to the pigment of claim 30 comprises reaction product of electrophile and nucleophilic polymer followed by reaction with acylating agent while the organic group attached to the pigment of claim 21 only requires reaction product of (2-sulfatoethyl)-sulfone, i.e. electrophile, and nucleophilic polymer. That is, the organic group of claim 21 is broader than that of claim 30 because it is not required that the organic group is made using acylating agent. The same arguments are made against claim 34 which fails to further limit the scope of the claim on which it depends, namely, claim 38 given that claim 38 recites ink

comprising pigment having attached organic group wherein the organic group comprises the reaction product of at least one electrophile and a nucleophilic polymer which is then further reacted with an acylating agent while claim 34 only requires reaction of (2-sulfatoethyl)-sulfone, i.e. electrophile, and nucleophilic polymer.

NOTE: If applicants submit another amendment in response to examiner's position as stated above, it is noted that the amendment will be considered even though it is after-final.



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
9/25/03